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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,933	11/13/2003	Achim Buchholz	P-US-PR 1090	9887

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EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/712,933

Applicant(s)

BUCHHOLZ, ACHIM

Examiner

Michael W. Talbot

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "base (44) of the insert (42) is shaped like a number" recited in claims 9 and 20 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 4 recites the identical claim limitation of "the

Art Unit: 3722

second through hole is formed by two overlapping axially offset circular cross-sectioned through holes" to that recited in independent claim 1 (from which claim 4 directly depends from).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5,7,9,10,12-18,20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lafforgue et al. '892. Lafforgue et al. '892 shows in Figures 3-6 a tool holder (1) comprising a tube like tool holder main body (1) have a side wall formed including a radially inward facing surface and formed with a first through hole (2') for receiving for receiving a locking body (6') for releaseably engaging a corresponding axial closed groove of a shank inserted within the tool holder and also formed with a second through hole (2). Lafforgue et al. '892 shows at least one hardened metal driving rib (11) located on an insert (3) fitted within the second through hole so that the rib extends axially and radially inward (Fig. 3) for engaging a corresponding axial rearwardly open driving groove of the shank inserted within the tool holder (col. 3, lines 3-6). Lafforgue et al. '892 shows the second through hole formed in an oblong truncated cone directly corresponding to the shape of the insert base (10). Lafforgue et al. '892 shows the second through hole being circumferentially offset with respect to the first through hole for receiving the locking body (Fig. 4). Lafforgue et al. '892 shows the insert is secured without play via friction or press fitting.

Lafforgue et al. '892 does not disclose expressly that the second through hole is formed by at least two overlapping axially offset circular cross-sectioned through holes, with constant diameters, corresponding to the shape of the insert base. Instead, Lafforgue et al. '892

Art Unit: 3722

indicates that the corresponding shape is an oblong truncated cone or can be any shape provided the through holes and base have corresponding matching shapes (col. 1, lines 32-41 and col. 1, line 52 through col. 2, line 27). At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select "at least two overlapping axially offset circular cross-sectioned through holes with constant diameters and a matching shaped driving insert" because Applicant has not disclosed that the "particular shaped of the through hole and matching insert" provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the driving insert/through hole combination of Lafforgue et al. '892, and Applicant's driving insert/through hole combination to perform equally well with either the oblong truncated cone shape taught by Lafforgue et al. '892 or the claimed "at least two overlapping axially offset circular cross-sectioned through holes, with constant diameters, and a matching cylindrical driving insert" because both shapes would provide the required surface area contact to transmit a high torque to drive the tool.

Furthermore, Applicant does not provide any criticality or unexpected results for the "at least two overlapping axially offset circular cross-sectioned through holes, with constant diameters, and the corresponding shaped insert base" as recited in claims 1 and 5.

5. Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lafforgue et al. '892 in view of Bailey et al. '820. Lafforgue et al. '892 lacks the insert being secured within the second through hole by at least one of press-fitting, adhesion, soldering and welding. Bailey et al. '820 shows in Figure 1 a tool holder comprising an insert (28) press fitted within a through hole (25) for rotary driving (col. 2, lines 46-55). In view of this teaching of Bailey et al. '820, it would have been obvious to one of ordinary skill in the art to modify the tool holder of Lafforgue et al. '892 to include a press fitted connection between the insert and

Art Unit: 3722

through hole as taught by Bailey et al. '820 to ensure the driving connection would be without play, thus improving the driving efficiency and durability.

6. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lafforgue et al. '892. Lafforgue et al. '892 discloses the claimed invention except for the hardened driving rib being made of carbide material. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to manufacture the hardened driving rib out of a carbide material, because it has been held to be within the general skill of a worker in the art to select a known material composition on the basis of its suitability for the intended use as a matter of obvious design choice.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's

Art Unit: 3722

office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT
Examiner
2 February 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER